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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,529	01/29/2004	Brian Bernard McKeon		5527

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SYDNEY, NSW, 2086  
AUSTRALIA

EXAMINER

TABOR, AMARE F

ART UNIT	PAPER NUMBER
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2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/767,529	<b>Applicant(s)</b> MCKEON, BRIAN BERNARD	
	<b>Examiner</b> Amare F. Tabor	<b>Art Unit</b> 2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 2,5,7 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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#### DETAILED ACTION

1. Claims 1 – 8 have been examined.
2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in AUS on 01/31/2003. It is noted, however, that applicant has not filed a certified copy of the 2003900413 application as required by 35 U.S.C. 119(b).

#### *Specification*

3. The reference is objected to because it contains an embedded hyperlink (***www.multos.com***) and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code.
4. The paragraph numbering of the disclosure starts from [0110].  
The examiner suggests numbering the paragraphs starting from [001].
5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. Correction of the following is required: (a) the terms "***cryptographic ticket***" and "***trusted module***" in Claim 1 are not defined in the disclosure; (b) the trusted modules, "***USB token***" or "***smartcard***" mentioned as an example in Claims 3, 6 and 7 are not defined in the disclosure.
6. Claim 2 is objected to because of the following informalities: Claim 2 recites "A computer system of method 1". It is unclear what method the applicant is referring, because claim 2 is a system claim and claim 1 is a method claim.  
Claims 5 and 7 are also objected for the same reason.  
Appropriate correction is required.
7. Claim 8 is objected to because of the following informality: The first sentence "A computer system based on the method of 7" is repeated in the second sentence.

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The examiner suggests the first sentence to be deleted.

Furthermore, Claim 7 is a method claim and claim 8 is a system claim that is dependent on claim 7.

***Drawings***

8. Since drawing(s) help to understand the invention more clearly, the examiner suggests to the applicant to include drawing(s) in the application.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

As disclosed in the claim, issuing a **pre-determined** number of public-key certificates is not specific and credible. Claim 1 recites the limitation "**providing a cryptographic ticket to a trusted module**", this is a program per se and computer hardware needs to implement or execute the method. Thus, the claimed invention is directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim(s) contains subject matter - "**cryptographic ticket**" - that was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

11. Similarly, Claims 2, 3, 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 8 provide for the use of ***"a computer system based on method 1"*** but, since the claim do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Regarding claims 3, 6 and 8 the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.C.S. 102(b) as being unpatentable over Kay, (US Patent No. 6,223,166 B1)

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As per claim 1, Key discloses:

- **a method for providing a cryptographic ticket to a trusted module allowing that module to issue a pre-determined number of public-key certificates** (Abstract lines 1-10, "**A cryptographic encoded, ticket issuing** and collection system for real-time purchase of tickets by purchasers at **remote user stations** in an information **network** that includes a plurality of remote user stations coupled to a **server** in an information network, e.g., the Internet, for purchase of services, products, or tickets to an event. An electronic ticket is transmitted to the operator and includes a cipher code created using a **public key** cryptography system.") The remote user stations in the prior art are used as trusted modules.

As per claim 2,

**Claim 2 is a computer system** claim corresponding to the method of claim 1 and rejected under the same reasons set forth in connection of the rejection of claim 1 and further as per claim 2, Kay discloses a computer system comprising: display means, keyboard, printer, coupled memory & processor, (column 3, lines 49-51, "In FIG.2, the remote user station 12 includes a **memory** 13 coupled through an **electrical bus** 15 to a **processor** 17, a **printer** 19, a **keyboard** 21, and a **display** 23.)

As per claim 3,

**Claim 3 is a computer system** claim corresponding to the method of claim 1 and rejected under the same reasons set forth in connection of the rejection of claim 1 and 2

- **where the trusted module is a hardware token such as a USB or a smartcard** (column 1, lines 31-38, "However, the increasing number of personal computers and PC kiosks suggest a new form of electronic ticket which is hybrid between a completely electronic **smart card** (or similar) ticket and current paper-based tickets produced by ticket agents).

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As per claim 4,

**Claim 4 is a method** claim corresponding to the method of claim 1 and rejected under the same reasons set forth in connection of the rejection of claim 1

- **where the cryptographic ticket is a public-key or private-key certificate** - the specification of Kay discloses similar information, ( column 4, lines 15-18 "The **digital signature** is created by the seller recording a message in the ticket using his **private key**. The validity of the message can be checked using the seller's **public key**"). Thus, the digital signature, which is a synonym for digital certificate, is recorded and verified by using public and private keys.

As per claim 5,

**Claim 5 is computer system** claim corresponding to the method of claim 4 and rejected under the same reasons set forth in connection of the rejection of claims 4 and 2.

As per claim 6,

**Claim 6 is a computer system** claim **where the trusted module is a hardware** corresponding to the method of claim 4 and rejected under the same reasons set forth in connection of the rejection of claims 4 and 3.

As per claim 7,

**Claim 7 is a method** claim corresponding to the method of claim 1 and rejected under the same reasons set forth in connection of the rejection of claim 1

- **where the pre-determined number of certificates that can be issued is determined by information within the provided cryptographic ticket**, the prior art disclose the same information, (column 2, lines 9-14, recite "the tickets are distributed electronically and **include cipher code** for authenticating the use of the tickets by a holder via portable terminals decrypting, validating and recording the cipher coded tickets, **the recorded ticket collection information** subsequently checked for duplication by uploading to a

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host system"); since the tickets (or the digital certificates) in the prior art include cipher codes and the system records ticket information for checking purposes, issuing the tickets is determined by the information provided by the cryptographic tickets.

As per claim 8,

**Claim 8 is a computer system claim where the trusted module is a hardware** corresponding to the method of claim 7 and rejected under the same reasons set forth in connection of the rejection of claims 7 and 3.

### **Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

TITLE: System and Method for Enabling Different Grades of Cryptography Strength in a Product,  
US 6,308,266 B1

TITLE: Electronic Commerce Using a Secure Courier System, US 5,671,279 A

TITLE: Electronic Funds Transfer Instruments, US 5,677,955 A

TITLE: Method and Apparatus for Retrieving X.509 Certificates from an X.500 Directory, US  
5,774,552 A

TITLE: System and Method for Safety Distributing Executable Objects, US 5,978,484 A

TITLE: Method and Apparatus for Cryptographically Camouflaged Cryptographic Key Storage,  
Certificate and Use, US 6,170,058

TITLE: Network Security System Allowing Access and Modification to a Security Subsystem After  
Initial Installation When a Master Token is in Place, US 6,212,635



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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amare F. Tabor whose telephone number is (571) 270-3155. The examiner can normally be reached on Mon-Fri 7:30a.m. to 5:00p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chameli Das can be reached on (571) 270-1392. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AFT

*Chameli C. Das*

**CHAMELI DAS  
SUPERVISORY PATENT EXAMINER**

*4/24/07.*